

REMARKS

In response to the Office Action dated March 6, 2008, the Applicant has amended claims 1, 15, 18 and 25. Claims 1-6, 8-17 and 19-33 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-3, 5, 6, 8, 14 and 25-30 under 35 U.S.C. § 102(b) as allegedly being anticipated by Wang et al. (U.S. Patent No. 5,490,217). The Office Action rejected claims 15-17, 32 and 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang et al. The Office Action rejected claims 9-13 and 19-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang et al. in view of Official Notice. The Office Action rejected claim 31 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wang et al. in view of the Applicant's Background of the Invention.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's claimed invention now includes printing a three-dimensional version of the photo-based image on the media and associating the encoded digital image copy with the three-dimensional version of the photo-based image. Support for this amendment can be found throughout the specification, and in particular, FIGS. 2 and 6 and paragraph [0031] of the Applicant's published patent application, U.S. Patent Publication No. 2005/0018250 A1.

In contrast, Wang et al., alone or in combination with the Applicant's Background of the Invention is clearly missing the above newly added features as specifically claimed. For example, although Wang et al. disclose using machine readable image code for document handling, the machine readable image code is only one or two-dimensional (see at least col. 2, lines 28-33 and col. 4, lines 20-29 of Wang et al.), and not the Applicant's three-dimensional version of the photo-based image, which is printed on the media and associated with the encoded digital image copy. Consequently, since Wang et al. do not disclose, teach or suggest all of the features of the Applicant's claimed invention, Wang et al. cannot anticipate the claims nor can Wang et al. render the claims obvious.

Further, with regard to the obviousness rejections, even though the combined references do not disclose, teach, or suggest all of the features of the Applicant's claimed invention, Wang et al. should **not** be considered because Wang et al. teach away from the Applicant's claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, Wang et al. **explicitly** require that the system use "...a two-dimensional machine readable image code..." (see Abstract, Summary and col. 4, lines 20-29 of Wang et al.). The two-dimensional machine readable image code in Wang et al. is **required** for proper operation. In contrast, the Applicant's claimed invention prints a three-dimensional version of the photo-based image on the media and associates it with the encoded digital image copy. Consequently, the proposed modification or combination would render Wang et al. being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Wang et al. being modified.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicant's claimed elements are **not** disclosed, taught or suggested by the combined references and because Wang et al. **teach away** from the Applicant's invention, Wang et al. **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejection should be withdrawn. *MPEP 2143*.

Last, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis.

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(MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicant in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicant's claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly requests the Examiner to telephone the Applicant's attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to

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